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EXAMINER	
PARK, GEORGE M	

ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/723,821	SUPER ET AL.	
	Examiner	Art Unit	
	GEORGE PARK	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: The sentence "...prize drawing books to filled out by said respondents" (page 12, line 8) should be --…prize drawing books to **be** filled out by said respondents--. Also, the term "abut" should be --about-- (page 13, line 2). Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-6 and 8-13, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 8 recite the terms "code numbers", "secured codes" and "security code". It is not clear as to whether the terms are the same.

Claims 2-6 and 9-13 are rejected for incorporating the above errors from their respective parent claims by dependency.

Furthermore, regarding claim 8, it is not clear what structure is implied to "a kit" (preamble) for the limitation "recruiting respondents to participate in market research evaluation of a program and entering a prize drawing", "secured codes to be entered by said respondents for accessing said DVD in order to view said program and said commercials in said DVD in one sitting", "program evaluations filled out by said respondent after viewing said program and said

commercials in said DVD", "questions for each said respondent to verify said program was viewed correctly and to ask survey questions to each said respondent and requesting that each said respondent view additional information on said DVD", "new security code to access said new information on said DVD supplied to each said respondent agreeing to view said additional information on said DVD" and "questions for each said respondent agreeing to view additional information on said DVD about said new information after said viewing."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldten (U.S. Pat. No. 7,212,988 B1) in view of Kelly (U.S. Pat No. 5,913,204) and further in view of Joao (U.S. Pub. No. 2001/0056374 A1).

Regarding claim 1, Feldten discloses the invention substantially as claimed. Feldten discloses a method of conducting marketing research (i.e. test screening) (column 1, lines 52-54), the steps comprising: recruiting respondents (i.e. test audience) to participate in market research evaluation of a program (column 2, lines 42-46), code numbers to access said program (column 1, lines 67 to column 7, lines 1-3), instructions for respondents (column 10, lines 15-17); viewing said program by accessing with said secured codes by said respondent in one sitting (i.e. designated date/time) (column 9, lines 52-57); filling out program evaluations by said respondent (column 10, lines 33-37); and calling each said respondent requesting (i.e. asking) each said respondent view additional information (i.e. continued interest) (column 6, lines 33-35); However, Feldten does not explicitly disclose using DVD technology, entering a prize drawing; sending a package to each of the recruited respondents, said package including a DVD containing commercials to be evaluated, said package further including instructions for respondents to read and prize drawing books to filled out by said respondents; calling each said respondent to verify said program was viewed correctly and to ask survey questions to each said respondent; supplying each said respondent agreeing to view said additional information on said DVD with new security code to access said new information on said DVD; asking each said respondent agreeing to view additional information said DVD about said new information after said viewing; and mailing back said DVD and filled out prize books. Kelly et al. discloses sending a package (i.e. test kit) including a compact disc to each of the recruited respondents

(column 1, lines 8-13, column 2, lines 15-16), calling each said respondent to verify that the test procedure was followed properly (column 6, lines 17-23), to ask survey questions (column 3, lines 50-53) and instructions for returning (i.e. mailing back) the package (i.e. test kit) (column 2, lines 13-15). It is common knowledge in the prior art for the package (i.e. test kit) to include other data storage media such as DVDs containing commercials, TV shows, movies, etc. to be evaluated, supplying each said respondent agreeing to view said additional information on said DVD with new security code to access said new information on said DVD and asking each said respondent agreeing to view additional information said DVD about said new information after said viewing when asking each respondent to view additional information (i.e. continued interest). Furthermore, Joao discloses entering a prize drawing (i.e. compensation) for advertisement viewing and survey participation (paragraph [0002], lines 1-10). It is common knowledge in the prior art for the package (i.e. test kit) to include instructions for respondents to read and fill out prize drawing books (i.e. compensation) for viewing programs and commercials and for participating in the market research. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Feldten with the feature of using DVD technology, entering a prize drawing; sending a package to each of the recruited respondents, said package including a DVD containing a program and commercials to be evaluated, said package further including instructions for respondents to read and prize drawing books to filled out by said respondents; calling each said respondent to verify said program was viewed correctly and to ask survey questions to each said respondent; supplying each said respondent agreeing to view said additional information on said DVD with new security code to access said new information on said DVD; asking each said respondent

agreeing to view additional information said DVD about said new information after said viewing; and mailing back said DVD and filled out prize books as taught by Kelly and Joao, as Feldten, Kelly and Joao are all directed to method of conducting marketing research. The motivation for doing so would have been to conduct market researching of programs and commercials by sending a package directly to the respondents and providing compensation to respondents for participating.

Regarding to claim 2, Feldten discloses wherein said secured codes (i.e. ID/PIN) demographically identify the user and determine whether said user is to view a program (column 8, lines 37-44).

Regarding to claim 8, Feldten discloses the invention substantially as claimed. Feldten discloses conducting marketing research, comprising: recruiting respondents (i.e. test audience) to participate in market research evaluation of a program (column 2, lines 42-46); code numbers to access said program (column 1, lines 67 to column 7, lines 1-3), instructions for respondents (column 10, lines 15-17); secured codes to be entered by said respondents in order to view said program in one sitting (i.e. designated date/time) (column 9, lines 52-57); program evaluations filled out by said respondent after viewing said program (column 10, lines 33-37); questions (i.e. quizzing) for each said respondent to verify said program was viewed correctly (i.e. column 2, lines 5-7) and to ask survey questions to each said respondent (column 2, lines 23-24). However, Feldten does not explicitly disclose a kit using DVD technology, entering a prize drawing; a package including a DVD containing a program and commercials to be evaluated, said package further including instructions for respondents to read and prize drawing books to be filled out by respondents agreeing to participate in said evaluation; new security code to access said new

information on said DVD supplied to each said respondent agreeing to view said additional information on said DVD; questions for each said respondent agreeing to view additional information on said DVD about said new information after said viewing; and means for returning said DVD and filled out prize books. Kelly et al. discloses sending a kit including a compact disc to each of the recruited respondents to be evaluated (column 1, lines 8-13, column 2, lines 15-16), to ask survey questions (column 3, lines 50-53) and instructions for returning (i.e. mailing back) the kit (column 2, lines 13-15). It is common knowledge in the prior art for the kit to include other data storage media such as DVDs containing commercials, TV shows, movies, etc. to be evaluated, supplying each said respondent agreeing to view said additional information on said DVD with new security code to access said new information on said DVD and asking each said respondent agreeing to view additional information said DVD about said new information after said viewing when asking each respondent to view additional information (i.e. continued interest). Furthermore, Joao discloses entering a prize drawing (i.e. compensation) for advertisement viewing and survey participation (paragraph [0002], lines 1-10). It is common knowledge in the prior art for the kit to include instructions for respondents to read and fill out prize drawing books (i.e. compensation) for viewing programs and commercials and for participating in the market research. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Feldten with the feature of a kit for conducting marketing research using DVD technology, entering a prize drawing; a package including a DVD containing a program and commercials to be evaluated, said package further including instructions for respondents to read and prize drawing books to be filled out by respondents agreeing to participate in said evaluation; new security

code to access said new information on said DVD supplied to each said respondent agreeing to view said additional information on said DVD; questions for each said respondent agreeing to view additional information on said DVD about said new information after said viewing; and means for returning said DVD and filled out prize books as taught by Kelly and Joao, as Feldten, Kelly and Joao are all directed to conducting marketing research. The motivation for doing so would have been to conduct marketing research of programs and commercials by sending a kit directly to the respondents and providing compensation to respondents for participating.

Regarding to claim 9, Feldten discloses wherein said secured codes (i.e. ID/PIN) demographically identify the user and determine whether said user is to view a program (column 8, lines 37-44)

6. Claims 3-6 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldten (U.S. Pat. No. 7,212,988 B1) in view of Kelly (U.S. Pat No. 5,913,204) in view of Joao (U.S. Pub. No. 2001/0056374 A1) and further in view of Diercks (U.S. Pub. No. 2004/0125075 A1).

Regarding to claims 3-6 and 10-13, Feldten, Kelly and Joao discloses the invention substantially as claimed. However, Feldten, Kelly and Joao do not disclose wherein said secured codes determine whether said user views advertisements after said program (as per claims 3 and 10), wherein said secured codes determine which advertisements said viewer views after a first segment of said program (as per claims 4 and 11), after a second segment of said program (as per claims 5 and 12) and after a third segment of said program (as per claims 6 and 12). Diercks discloses a DVD wherein the viewer enters secured codes (i.e. numeric codes) to gain access to

the disc or certain sections (i.e. segments) of the program (paragraph [0009], lines 3-8). Repeating the technique of determining which advertisements said viewer views for a plurality of segments of said program is considered the equivalent of duplication for multiple effect. Mere duplication of parts has no patentable significance unless new and unexpected result is produced. See *In re Harza*, 124 USPQ 378 (CCPA 1960). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Feldten, Kelly and Joao, with the feature of wherein said secured codes determine whether said user views advertisements after said program (as per claims 3 and 10), wherein said secured codes determine which advertisements said viewer views after a first segment of said program (as per claims 4 and 11), after a second segment of said program (as per claims 5 and 12) and after a third segment of said program (as per claims 6 and 13) as taught by Diercks. The motivation for doing so would have been for the viewer to view and evaluate specific contents (i.e. programs/commercials) on the DVD tailored specifically for the viewer based on secured codes.

7. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldten (U.S. Pat. No. 7,212,988 B1) in view of Kelly (U.S. Pat No. 5,913,204) in view of Joao (U.S. Pub. No. 2001/0056374 A1) and further in view of Pirot et al. (U.S. Pub No. 2001/0024411 A1).

Regarding to claims 7 and 14, Feldten, Kelly and Joao discloses the invention substantially as claimed. However, Feldten, Kelly and Joao do not disclose wherein said DVD is programmed to be ejected if played on a Personal computer (PC) connected drive in order to prevent the DVD from being copied and played later. Pirot et al. discloses preventing optical

disks (i.e. DVDs) from illegal copying by writing (i.e. programmed) a copy protection code and ejecting the disk (paragraph [0003], lines 1-8, paragraph [0037], lines 1-2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Feldten, Kelly and Joao with the feature of wherein said DVD is programmed to be ejected if played on a Personal computer (PC) connected drive in order to prevent the DVD from being copied and played later as taught by Pirot et al. The motivation for doing so would have been to prevent the respondents of violating marketing research procedures by copying the DVD and viewing the contents on the DVD in more than one sitting or multiple times.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Von Kohorn (U.S. Pub. No. 2001/0003099 A1) discloses a system and method for evaluating responses to broadcast programs.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GEORGE PARK whose telephone number is (571)270-3547. The examiner can normally be reached on Monday - Friday (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GP
3/13/08
/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623